

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed December 19, 2003 (the "Office Action"). In the Office Action, the Examiner rejects Claims 37 and 40, allows Claims 5-12, 24-27, 32-33, 36 and 39 and objects to matter previously added to the Specification. In order to advance prosecution of this case and further narrow issues for appeal, Applicant cancels Claims 5-12, 24-27, 32-33, 36 and 39 and matter previously added to the Specification by amendment without prejudice or disclaimer. Even if the Examiner persists in his rejections, Applicant requests entry of this amendment to put the Application in better condition for appeal. Reconsideration of the application is respectfully requested.

Objection under 35 U.S.C. §132

The Office Action objects under 35 U.S.C. §132 to matter added to the Specification by amendment. Applicant cancels the amended matter in the Specification without prejudice or disclaimer in order to advance prosecution and further narrow the issues for appeal.

Rejections under 35 U.S.C. §112

Claims 37 and 40 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action contends that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. *See* Office Action, page 2, ¶ 2. These rejections are respectfully traversed.

The Office Action states:

Neither the drawings nor the disclosure show the fasteners or the fastener and attachment connecting the connecting joint member to the ends of the lower and upper post members, and the specification is not enabled for teaching the first and second fasteners, when referred to the welding joint of the connecting member to the upper or lower posts.

Office Action, page 2, ¶ 2. Applicant respectfully disagrees. As Applicant previously submitted, Figures 4-6 illustrate an embodiment with a connecting joint member (bracket

152) connected to an upper post member (upper portion 142) by a first fastener (pivot pin 154, shear pin 156 and bracket 150). *See* Specification, page 20, line 3 - page 21, line 14.

Claims 37 and 40 have sufficient breadth that an alternative reading of the claims on the embodiment illustrated in Figures 4-6 is possible. In an alternative interpretation, the claimed upper post member constitutes upper portion 142 and bracket 150. *See, e.g., CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1367-68 (Fed. Cir. 2002) (holding that the claim term "member" could comprise multiple components). In such instance, Figures 4-6 illustrate an embodiment with a connecting joint member (bracket 152) connected to an upper post member (upper portion 142 and bracket 150) by a first fastener (pivot pin 154 and shear pin 156). *See* Specification, page 20, line 3 - page 21, line 14.

Connecting joint member (bracket 154) is connected to a lower post member (lower portion 144) by a second fastener or attachment ("bracket 152 attached to the end of lower portion 144"). *See id.* As previously submitted by Applicant, the definition of "attachment" is "[s]omething . . . that attaches one thing to another." *See* Amendment Under 37 C.F.R. § 1.111 filed April 24, 2003 (citing *The American Heritage College Dictionary* (3rd ed.)). Applicant's specification also refers to the connection between bracket 152 and lower portion 144 as an "attachment." *See, e.g.,* Specification, page 20, lines 28-31. Thus, Applicant discloses an attachment or fastener connecting bracket 152 and lower portion 144.

The first fastener of the embodiment illustrated in Figures 4-6 includes a first connector (pivot pin 154) having a first failure strength greater than a second failure strength of a second connector (shear pin 156) of the first fastener such that upon an impact force being applied along a weak impact axis, the second connector (shear pin 156) fails and the upper post member (upper portion 142 and bracket 150) rotates about the first connector (pivot pin 154).

The Examiner additionally contends that the specification does not "show this combination with the two fasteners, or fastener and attachment have different failure

strengths while connecting the connecting member to the corresponding posts." *See* Office Action, page 3, ¶ 2. The Office Action states:

[T]here is nothing in the drawings that would indicate that the attachment, referring to the welds, is stronger than the fastener 156. Welds are made of different materials, and done [many] different ways, and can be done to be frangible under certain loads. It is not inherent that [the] attachment, as indicated by the figures, would have greater failure strength than that of the fastener.

Id. Applicant respectfully disagrees. Figure 6 illustrates the failure of shear pin 156 as a result of a vehicle impact, while bracket 152 remains attached to lower portion 144. *See* Specification, page 21, lines 8-12 and Figure 6. It is true that one may design particular embodiments that include an attachment between a bracket and a lower portion of a support post that is frangible under different loads in the different embodiments. However, those embodiments will not work for their intended purpose in the Application unless the failure strength of the attachment between bracket 152 and lower portion 144 is greater than the failure strength of shear pin 156. For example, one such intended purpose allows for an upper portion of a post to deflect and then break off from a lower portion upon vehicle impact to "minimize lifting of the impacting vehicle into the air." Specification, page 8, lines 8-11. Applicant discloses such an embodiment with respect to Figures 4-6 that works for this intended purpose. Thus, to work for its intended purpose, it is inherent that the shear pin 156 has a failure strength less than a failure strength of the attachment between bracket 152 and lower portion 144.

Therefore, for at least the reasons stated above, Applicant respectfully requests that the written description requirement rejection of Claims 37 and 40 under 35 U.S.C. §112, first paragraph, be withdrawn.

Applicant additionally notes that the Office Action states that "applicant argues that the decisions made by the Examiner and prior Examiner, Examiner Kim, is bidding [sic] on future decisions by the Examiner. The Examiner disagrees, the examiner is not bound to any decision made in prior office actions." Office Action, page 3, ¶ 2. Applicant, however, never argued that any previous decision of an examiner was binding on future decisions. Applicant

simply pointed out that multiple Primary Examiners of the PTO, including previous Primary Examiner Harry Kim and current Examiner Cottingham, have previously indicated that pending subject matter currently rejected under the first paragraph of §112, was in fact in compliance with the first paragraph of §112.

As indicated in the quotation set forth above from page 2, ¶ 2 of the Office Action, the Examiner also contends that the specification is "not enabled" for teaching the first and second fasteners. While Claims 37 and 40 are only formally rejected as failing to comply with the written description requirement of the first paragraph of 35 U.S.C. §112, Applicant will nevertheless address this enablement contention. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). Applicant discloses a particular embodiment in which a pivot pin 154 and a shear pin 156 each extend laterally through respective adjacent portions of brackets 150 and 152 and bracket 152 is attached to lower portion 144. *See* Specification, page 20, line 3 - page 21, line 7. Moreover, Figures 4 and 5 illustrate pivot pin 154 and shear pin 156 extending laterally through respective adjacent portions of brackets 150 and 152 and bracket 152 attached to lower portion 144. Applicant respectfully submits that one of ordinary skill in the art would be able to connect a bracket 152 to bracket 150 using, for example, a shear pin and a pivot pin, and to connect the bracket 152 to a lower portion 144 of a support post without undue experimentation. Therefore, Applicant's specification contains sufficient information to enable one skilled in the art to make or use the claimed invention without undue experimentation.

Request for Interference

Applicant maintains its request that an interference involving Claims 37 and 40 be declared between the present Application and U.S. Patent No. 5,988,598 issued to Sicking et al. (the '598 Patent).

CONCLUSION

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. Further, it is respectfully requested that an interference involving Claims 37 and 40 be declared between the present application and the '598 Patent. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6511.

Applicant believes that no fee is due. However, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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